

Serial No.: 09/110,987

- 2 -

13005sh

"Applicant's amendment necessitated new grounds of rejection presented in this Office Action." However, the Office Action is in response to Applicant's appeal of the Examiner's previous final rejection. As such, Applicant did not make any further amendments that necessitated new grounds of rejection. Therefore, Applicant respectfully requests that the Office Action be considered non-final and the following remarks be fully considered. The Examiner also indicated MPE§706.07 (a) as a rule related to why this Office Action is final. However, this section of the MPEP is directed to final office actions that are second actions. Applicant submits that this Office Action should be considered a first Office Action considering it follows an appeal for which Applicant paid appeal fees.

Claims 1-3 and 5-9 are pending in the present application. The Applicant disagrees with the Examiner's position that the claimed invention is obvious over the combination of U.S. Patent No. 4,607,774 to Garr and U.S. Patent No. 3,229,875 to Stoller. As a first issue, there is no motivation in the prior art for combining the two references. In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Serial No.: 09/110,987

- 3 -

13005sh

Garr merely discloses a wrapping table to dispense plastic film. It is not directed to dispensing film with an adhesive on one surface or to dispensing film to be placed on the hand of an adult user. In addition, Garr lacks a base member applicable for the purpose of placing the palmar surface of an adult hand for adhesion by the film. The Garr disclosure does not motivate a combination with the device of Stoller. Stoller narratively discloses a dispenser for flexible plastic articles but does not show anything that would allow a user to place an adhesive coated sheet on to a human hand. The present invention discloses a novel dispenser that allows application of an adhesive coated plastic film to an adult hand. Neither of the cited references disclose or suggest a solution to this problem nor in any way motivate a solution. Even if the two references were combined, despite the lack of motivation in the prior art, the combination does not provide anything close to the present invention. Instead, the combination merely provides a dispenser for non-adhesive plastic film with no provision for attaching the film to a human hand.

The Examiner makes the argument that the difference between the combination of Stoller and Garr, and the present invention, is merely a matter of a change in size. On the contrary, the present invention provides an entirely different configuration than either of the cited references or some combination of the two. Neither reference provides a space for the palm of a hand to contact the sheeted material. Garr provides only a very small area that may be considered some type of base, although this area is certainly not designed, configured or sized for the purpose of the present invention.

Serial No.: 09/110,987

- 4 -

13005sh

Even if the difference between the cited combination and the present invention were merely a matter of size, this does not make the present invention obvious. The Examiner cites In re Rose, 105 USPQ 237 (CCPA 1955) for the proposition that a change in size is generally recognized as being within the level of ordinary skill in the art. This is true only where the change in size provides no unexpected benefit. In the present case, the configuration of the present invention provides a completely different utility than either of the cited references. Even if this were "merely a change in size," this change has resulted in the creation of an entirely new invention.

The Examiner also argues that the use of resilient base member is merely an obvious change in material and cites In re Leshin, 125 USPQ 416. Presumably, this argument is directed towards Applicant's claim 6 where the base member is specified to be resilient. This is not merely a matter of a change in materials that does not result in a change in the device. Instead, the resilient base material allows a person to "grip" the adhesive coated plastic sheet against the resilient base material allowing a better adhesion between the plastic sheet and the person's hand. If the material of the Garr device were changed from a steel material to a resilient material, the usefulness of the device would be seriously hampered. The device would no longer be operable to support an object to be wrapped on the wrapping table. As stated by the Supreme Court in Smith v. Goodyear Dental Vulcanite, 93 US 496 (1876), if "such a substitution involves a new mode of construction, or develops new uses and properties of the article formed, it may amount to invention... It may require contrivance, in which case the mode of making it would be patentable; or the result may be the production of an analogous but substantially different manufacture... where there is some such new and useful result, where a machine has acquired new functions and useful properties, it may be

Serial No.: 09/110,987

- 5 -

13005sh

patentable as an invention, though the only change made in the machine has been supplanting one of its materials by another. This is true of all combinations, whether they be of materials or processes. This is clearly the case in the present invention where the change in material makes a device that has entirely different utility than either of the cited references.

The Examiner has rejected claims 3 and 8, saying that it is "unclear how defining the work piece further defines the claimed invention." Claim 3 adds that the flexible film has spaced apart perforations, but also adds that the edge, a claimed element of the invention, is physically configured to separate the film at the perforation regions. Applicant submits that this does further define the invention. The limitations of claim 8 have been incorporated into claim 9.

Applicant submits that all claims are now in condition for allowance. Any questions should be directed to Applicant's below-signed representative.

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, PC. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

Serial No.: 09/110,987

- 6 -

13005sh

## VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

9. (Amended) The dispenser of claim [8] 1, wherein the flexible film is at least partially transparent, enabling a user to visualize the base member therethrough, and the base member includes hand-positioning visual indicia which a user can visualize through the film.

Respectfully submitted,

Date: May 30, 2001

By: 

John G. Posa  
Reg. No. 37,424  
Gifford, Krass, et al  
280 N. Old Woodward Ave.  
Suite 400  
Birmingham, MI 48009  
734/913-9300 Fax: 913-6007